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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,524	10/10/2001	Christopher R. Vincent	POU920010113US1	1514

23334 7590 02/28/2007

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EXAMINER	
BADII, BEHRANG	
ART UNIT	PAPER NUMBER
3694	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/976,524	VINCENT, CHRISTOPHER R.	
	Examiner	Art Unit	
	Behrang Badii	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-7,9,16-18,20,27-29,31 and 34-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-7, 9, 16-18, 20, 27-29, 31 and 34-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

Applicant's arguments filed on 11/14/06 have been fully considered but they are not persuasive. The previous 112 rejections are withdrawn. There are new ambiguities within the amended claims.

Serbinis discloses sharing files and tokens throughout the reference as discussed below.

Serbinis and Eldridge are both in the realm of tokens and sharing and having access to data via using tokens.

Eldrige clearly point out the limitations on the use of the tokens both in the realm of number of use and the duration of use. It is inherent that once a token is used up, it is removed from the system such that the next user is not able to use the token again. Hence, Eldridge points out the limiting number of use of the tokens as far as accessing the information by the used of the tokens described below.

2112 [R-3] Requirements of Rejection Based on Inherency; Burden of Proof

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 16 and 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the applicant is removing a token value in a novel manner. That is, Eldrige and Serbinis clearly points out that these tokens can be used for a certain amount of time and/or for a certain number of times. Therefore, the removal of a token value is just removing a token and is well known in the art. The novelty and the way that there should be given weight to the removal of the token is unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-9, 16-20 & 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al., U.S patent 6,314,425, and further in view of Eldridge et al., 2002/0095570.

P = paragraph, i.e. p1 = paragraph 1.

As per claims 5, 16 & 27, Serbinis et al. discloses a method/system/computer readable medium of controlling access to data on a computer (abstract), the method comprising:

Storing a list of valid token values (col. 21, 30-50; claim 1; abstract)

accepting a request for a data item, wherein the request comprises a received token value that is only accepted for a specified (predetermined limit) (col.20, 16-25) number of requests (col.3, 57-67; col.4, 1-4; col.20, 16-25; The tokens are used to limit the user's access);

determining that the received token value is within the list of valid token values (comparing tokens to a database of tokens that has saved the original tokens for this comparing part (col.21, 30-50) (col.4, 66-67; col.5, 1-19; col.3, 57-67; col.4, 1-4; col.20, 16-25; Validating the token and limiting the amount of time the token can request to use the system/data.); and

removing/deleting tokens from a list of tokens in a database (col.21, 52-59);

responding to the request by returning the data item in response to the determining that the received token value is valid (abstract; col.3, 57-67; col.4, 1-4; col.20, 16-25; Returning the data after the token has been validated and before the expiration time of the token, limiting the number of times the token can be used to request data from the system).

Serbinis does not disclose limiting the usage of the token such that it has been accepted for fewer than the specified number of requests. Eldridge et al. discloses limiting the usage of the token such that it has been accepted for fewer than the specified number of requests (p8). The removal of the token is inherent in

Eldridge and as is shown above the removal of the token is explicitly carried out in Serbinis It would have been obvious to modify Serbinis to include limiting the usage of the token such that it has been accepted for fewer than the specified number of requests such as that taught by Eldridge et al. in order to avoid replay attacks (p8).

As per claims 6, 17 & 28, Serbinis et al. further discloses charging (billing) an entity in response to retuning the data item the step in conjunction with the use of the token value (col.15, 30-38).

As per claims 7, 18 & 29, Serbinis et al. further discloses wherein the token value comprises an expiration time and wherein the determining further determines that the token value has not expired (col.21, 19-26).

As per claims 9, 20 & 31, Eldridge et al. and Serbinis et al. discloses wherein the list of stored and valid token values is shared with an entity that originated the data request (file sharing, and the token value (data) are in those files) (Eldridge et al.: p29, 31, 37 and 80-82) (Serbinis et al: abstract; col.2, 43-49).

As per claims 35 and 36, Serbinis further discloses periodically generating, with a period, a respective new list of valid token values (abstract; col. 21, 30-50; claim 1); sending, in response to the periodically generating, the new list of stored and valid token values to the associated computer (abstract; col. 21, 30-50; claim 1), wherein a respective expiration time of each token value in the new list of valid token values is based upon the period so as to cause generation of the

respective new list of valid token values prior to expiration of previously generated valid token values (abstract; col. 21, 30-50; claim 1; col.20, 16-25).

As per claims 37, Serbinis further discloses wherein the token value has been signed by the associated computer, and wherein the determining that the token value is valid and has been accepted for fewer than the specified number of requests comprises verifying the signed token value (abstract; col. 21, 30-50; claim 1; col.20, 16-25).

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al., U.S patent 6,314,425 as applied to claim 5 above, and further in view of Khater, U.S. patent application publication 2002/0184143 or Pisarsky 2002/0147838.

As per claim 34, Serbinis et al. discloses a method/system/computer readable medium of controlling access to data on a computer as discussed above. Serbinis et al. does not disclose wherein the token value is only accepted one time, and wherein the responding to the request is performed in response to the token value having not been previously accepted (code/password can only be used once; request is only accepted one time). Khater or Pisarsky disclose wherein the token value is only accepted one time, and wherein the responding to the request is performed in response to the token value having not been previously accepted (code/password can only be used once; request is only accepted one time) (Khater, p16) (Pisarsky, p5). It would have been obvious to modify Serbinis et al. to include wherein the token value is only accepted one time, and wherein the responding to the request is performed in response to the token value having

not been previously accepted (code/password can only be used once; request is only accepted one time) such as that taught by Khater or Pisarsky in order to reject any double usage of the code hence improving the security of the system since a after the code is used a new code has to be generated for the next request to go through the system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Corbin (U.S. patent 5,138,712) discloses an apparatus and method for licensing software on a network of computers.

Norris (U.S. patent 6,718,328) discloses a system and method for providing controlled and secured access to network resources.

Lau et al. (U.S. patent 6,182,124) discloses a token-based deadline enforcement system for electronic document submission.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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Hand delivered responses should be brought to

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Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(571) 272-3600**.

Behrang Badii
Patent Examiner
Art Unit 3694

BB

ELLA COLBERT
PRIMARY EXAMINER